



UNITED STATES PATENT AND TRADEMARK OFFICE

MN
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,451	05/31/2001	Robert Lennic	PALM-3667	3020
49637 7590 04/19/2007 BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069			EXAMINER SIDDIQI, MOHAMMAD A	
			ART UNIT	PAPER NUMBER
			2154	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/872,451	LENNIE ET AL.	
	Examiner	Art Unit	
	Mohammad A. Siddiqi	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-28 and 30-33 are presented for examination. Claim 29 has been cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/05/2007 has been entered.

Specification

3. The abstract of the disclosure is objected to because the abstract is not limited to a single paragraph within the range of 50 to 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 10, 22, and 23 contain the trademark/trade names Bluetooth and Mobitex. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Bluetooth and Mobitex and, accordingly, the identification/description are indefinite. See MPEP 7.35.01.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-28 and 30-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (6,850,757) (hereinafter Watanabe) in view of Mousseau et al. (US PUB 2002/0120696) (hereinafter Mousseau).

8. As per claims 1 and 27, Watanabe discloses a communication system and method for pushing electronic messages to a wireless portable device (arrival notification message is pushed by notification apparatus, col 2, lines 54-60) comprising: a mail server (102, fig 1) having an electronic mail interface configured to be coupled to the internet (104, fig 1, col 2, lines 48-60), for storing an electronic mail message received over the Internet (col 2, lines 37-60) and for generating a copy of said electronic mail message (Fig 1, col 2, lines 24-46);

a notifications server (100, fig 1, col 2, lines 24-36), coupled to said mail server (col 2, lines 24-36), and having a standard electronic mail

Art Unit: 2154

protocol for receiving said copy of said electronic mail message as a standard formatted electronic mail message (100, fig 1, col 2, lines 24-53);

wherein said notifications server (100, fig 1, col 2, lines 24-60) is for automatically generating (arrival notification mail, col 2, lines 24-60), therefrom, a subset of said received copy of said electronic mail message (col 5, lines 6-31); and

wherein said notifications server (col 2, lines 24-60), upon generation of said subset (subset is interpreted as message, col 5, lines 6-31), is for wirelessly transmitting (col 1, lines 5-10) said subset (subset is interpreted as message, col 3, lines 33-35) to an identified wireless electronic device (col 5, lines 6-31) associated with a user that is the recipient of said received electronic mail message (cellular phone, col 5, lines 6-39), and wherein the user subsequently is able to select the subset (subset is interpreted as body of the text, col 6, lines 18-33) and thereby download the remainder of the electronic mail message (col 6, lines 17-44).

The "prior art" (or "the system of") of Watanabe teaches notification apparatus (100, fig 1,) generating and notifying arrival of notification mail message to the wireless device (col 2, lines 24-60) and further suggest adding couple of short sentences to the notification message (col 5, lines 22-31). Watanabe does not specifically disclose generating a copy of said electronic mail message, therefrom, a subset of said received copy of said

electronic mail message. However, the Watanabe does teach notification apparatus (100, fig 1,) generating and notifying arrival of notification mail message to the wireless device (col 2, lines 24-60) and further suggest adding couple of short sentences to the notification message (col 5, lines 22-31). Mousseau generating a copy of said electronic mail message (page 7, paragraph #0070; page 8, paragraph #0076), therefrom, a subset of said received copy of said electronic mail message (page 7, paragraph #0070; page 8, paragraph #0076; and paragraph #0067). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Mousseau. The motivation (prior art of Watanabe at least suggests adding a couple of short sentence so user can determine whether the electronic mail should be read, col 5, lines 22-31, col 6, lines 18-33) would have been developing mail arrival notification system for notifying mobile user device extracted information from the original mail so user of the wireless device can determine whether the electronic mail should be read.

9. As per claim 14, the claim is rejected for the same reasons as claim 1, above. In addition, Watanabe discloses a plurality of wireless electronic devices operable to communicate over a wireless communication network (106, fig 1, col 2, lines 24-60).

10. As per claims 2, 15, and 28, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is operable to display received subsets to a user LCD display, (col 5, lines 29-31).

11. As per claims 3, and 16, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is operable to allow said user to select a particular received subset and wherein said notifications server is also for transmitting the remainder of an electronic mail message corresponding to said particular received subset in response to the selection thereof by said identified wireless electronic device (col 5, lines 45-67; col 6, lines 18-43).

12. As per claims 4 and 17, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses said subset is a notification message comprising a sender's identification and a subject field of said received electronic mail message (page 8, paragraph #0076).

13. As per claims 5 and 18, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless

electronic device is a handheld computer system having wirelessly enabled (fig 3, col 3, lines 28-36).

14. As per claims 6, 19, and 31, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses wherein said notifications server comprises a user information database for providing a mapping between wireless electronic devices and their associated electronic mail addresses (fig 3, col 3, lines 28-36).

15. As per claims 7, 20 and 32, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses a push packet (is used by said notifications server to wirelessly transmit said subset to said identified wireless electronic device (col 5, lines 22-28).

16. As per claims 8 and 21, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said subset is wirelessly transmitted using a wireless LAN communication network (elements of fig 1).

17. As per claims 9 and 22, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses, using a Bluetooth wireless communication network (page 22, paragraph #0174).

18. As per claims 10 and 23, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses using a Mobitex wireless communication network (page 21, paragraph #0164).

19. As per claims 11, 24, and 33, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses said standard electronic mail protocol is substantially compliant with the SMTP protocol (page 9, paragraph #0084).

20. As per claims 12 and 25, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses POP protocol (page 9, paragraph #0084).

21. As per claims 13 and 26, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses IMAP protocol (page 9, paragraph #0084).

22. As per claim 30, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device allowing said user to select a particular received notification message including the subset (col 5, lines 22-67; col 6, lines 18-43); and said notifications server transmitting the remainder of an electronic mail message corresponding to said particular received notification message in response to said user selecting said particular received notification message (col 5, lines 45-67; col 6, lines 18-43).

Response to Arguments

23. Applicant's arguments with respect to claims 1 and 27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Following U.S. Patent teaches pushing notification message to wireless devices.

US 6463463

US 6289212

US 6243739

US 6237027

US 6138158

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

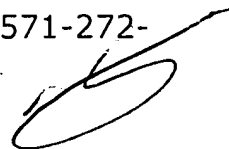
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NATHAN J. FLYNN

**SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800**



MAS